

IN THE

Supreme Court of the United States

Office - Supreme Court U.S.A.  
Date - APR 17 1944

October Term, 1943.

No. 855

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THE DOW CHEMICAL COMPANY, a corporation,

*Petitioner,*

vs.

HALLIBURTON OIL WELL CEMENTING COMPANY, a corporation,

*Respondent.*

CROSS PETITION AND BRIEF FOR  
RESPONDENT.

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## CROSS PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

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*To the Honorable the Chief Justice and to the Associate Justices of the Supreme Court of the United States:*

Respondent, Halliburton Oil Well Cementing Company, respectfully prays that a writ of certiorari issue to review the decree of the United States Circuit Court of Appeals for the Sixth Circuit in the case of *The Dow Chemical Company v. Halliburton Oil Well Cementing Company*, No. 9392, by which decree respondent was held to have infringed United States patent No. 1,877,504 if said patent be valid.

The Dow Chemical Company has filed a petition with this Honorable Court praying that a writ of certiorari issue to review the said decree of the Circuit Court of Appeals for the Sixth Circuit in so far as such decree holds that the said United States patent No. 1,877,504 is invalid. This petition of respondent is in the nature of a cross petition for certiorari to enable respondent to be heard upon the issue of infringement of said Letters Patent No. 1,877,504 in the event of a writ of certiorari issue upon the petition of The Dow Chemical Company.

A certified transcript of the record in this case has been filed in this Court by petitioner, The Dow Chemical Company. The decree [Vol. IV - 2051] and the opinion [Vol. IV - 2052] of the Circuit Court of Appeals were filed December 17, 1943, and a petition for rehearing was denied on January 31, 1944 [Vol. IV - 2077].

### **Jurisdiction.**

For the purpose of this cross petition respondent adopts the statements as to jurisdiction appearing upon page 2 of the petition filed by The Dow Chemical Company.

### **Statement and Reasons Relied Upon for Allowance of the Cross Writ.**

The sole question presented by the petition filed by The Dow Chemical Company to review the decree below is confined to the validity of the patent in issue, and The Dow Chemical Company in presenting its petition seeks to forestall any review by this Court of the holding be-

low that respondent has infringed the patent in suit if that patent be valid.

As more fully stated in the accompanying brief, the questions of validity and infringement of the patent in suit are dependent and so interwoven that a denial to respondent of a review of the question of infringement would be unjust if the petition of The Dow Chemical Company be granted and a review be had of the question of validity.

The reason assigned by The Dow Chemical Company why this Court should not review the question of infringement is that there are concurrent findings and conclusions by the Circuit Court of Appeals and the District Court against respondent on this issue. However, there are also concurrent findings and conclusions in this case in the Circuit and District Courts against The Dow Chemical Company as to the invalidity of the Letters Patent in issue. The existence of concurrent findings and conclusions in this case in the District and Circuit Courts should have the same effect before this Court upon the issues of validity and infringement. Either such concurrent findings and conclusions should preclude a review of both the issues of validity and infringement or they should preclude a review of neither.

#### **Question Presented.**

Respondent by this cross petition, in the event the petition of The Dow Chemical Company be granted, seeks a review of the holding below that respondent has infringed Letters Patent No. 1,877,504 if said Letters Patent are valid.

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Wherefore, respondent, Halliburton Oil Well Cementing Company, prays that this petition be granted and that the aforesaid question be determined by this Court in the event a writ of certiorari issue to the Circuit Court of Appeals for the Sixth Circuit granting a review of the decree of that Court in this case.

Dated at Los Angeles, California, April 14, 1944.

HALLIBURTON OIL WELL CEMENTING COMPANY,

By LEONARD S. LYON,

*Its Attorney.*

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**BRIEF FOR RESPONDENT.**

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I.

**Opinions of the Courts Below.**

The opinion of the Circuit Court of Appeals for the Sixth Circuit in this case is reported in 139 F. 2d 473 and appears in the printed record at pp. 2052 *et seq.*. No written opinion was filed by the District Court, but the District Court expressed its views upon the issues during the settlement of the findings of fact and conclusions of law as set forth in the printed record at pp. 1435-77 and by the entry of findings of fact and conclusions of law which are reproduced in the printed record at pp. 1478-92.

II.

**Jurisdiction.**

Although in the absence of a cross petition for certiorari respondent may be able to urge any point appearing in the record which will support the decree below, a cross petition to assure the right to raise such a point is in order.

*Honolulu Oil Corporation v. Halliburton*, 306 U. S. 550, 83 L. Ed. 980.

Respondent is presenting this cross petition to avoid any question of its right to be heard on the issue of infringement in the event the petition of The Dow Chemical Company for a writ of certiorari in this <sup>case</sup> <sub>A</sub> be granted.

III.

**Statement of the Case.**

Under this title The Dow Chemical Company in its brief completely misrepresents the nature and character of patent No. 1,877,504 involved in this case. This patent is not to be viewed as covering the first successful or any process for treating oil and gas wells with acid. As found by the courts below the use of hydrochloric acid for treating oil and gas wells was fully disclosed as early as 1896 in the prior Frasch patent No. 556,669. All that the patent in suit purports to add to such a process is the addition of a small amount of a chemical inhibitor to protect the well pipe from the hydrochloric acid. As

said in the opinion of the Circuit Court of Appeals below:

"The single question is whether the conception of adding a corrosion inhibitor to hydrochloric acid for use in acidizing wells in order to reduce corrosion requires anything more than the ordinary skill of the calling or involves any patentable invention."

The patent in suit (Vol. IV, - 1501-1503) discloses nothing more than adding a small amount of a substance capable of inhibiting attack of the acid upon the metal surfaces with which it comes in contact [p. 1, lines 75-80], and suggests for that purpose the addition of "a small amount, e. g., 1 to 5 per cent, of an arsenic compound" [p. 2, lines 73-4]. As found by the Court of Appeals the use of inhibitors to protect steel from hydrochloric acid was well known in the prior art dating from as early as 1845, and including the use of arsenic compounds.

Respondent is not charged with infringement of the patent in suit because it adds to the hydrochloric acid employed by respondent in acidizing a well any of the inhibitors named in the patent in suit or any other inhibitor of the type or in the quantity called for by the patent in suit. The hydrochloric acid employed by respondent in acidizing oil wells is transported from storage tanks to the wells to be acidized in steel transportation tanks. Respondent adds to the hydrochloric acid no corrosion inhibitor or agent capable of inhibiting the action of the acid upon steel unless the formation of metallic chlorides (lead and copper) in the transportation tanks be deemed

such an addition [Finding No. 87, Vol. III - 1491]. Respondent bonds a lead plate within the steel transportation tanks, thereby producing a battery action causing a flow of electric current from the lead plate through the acid to the steel wall of the transportation tank, and in this way protects the steel of the transportation tanks [Finding No. 88, Vol. III - 1491]. This battery action in respondent's transportation tanks results in the formation of minute amounts of copper, lead and iron chlorides incidental to the method used by respondent for protecting its transportation tanks [Finding No. 90, Vol. III - 1491]. The presence of such minute quantities of copper, lead and iron chlorides in the acid somewhat reduces the corrosive action of the acid, but even then the acid is many times more corrosive than that resulting from following the directions of the patent in suit [Finding No. 91, Vol. III - 1491]. If respondent omitted the lead plate in its transportation tanks, the acid, in lieu of attacking the lead plate, would attack the steel walls of the tanks and produce minute amounts of chlorides which would have the very effect complained of. Indeed it was shown that all commercial hydrochloric acid necessarily contains such chlorides because of the action of hydrochloric acid upon the metal equipment in which it is made and upon the metal equipment in which it is stored or transported. At the trial counsel for The Dow Chemical Company conceded that within their concept of the scope of the patent in suit hydrochloric acid could not be transported out to an oil field in a steel tank without infringing the patent.

In presenting this petition respondent should not be understood as subscribing to the grant of the petition of The Dow Chemical Company. While the patent in suit was held valid by the Circuit Court of Appeals for the Tenth Circuit in 1936 in *Dow Chemical Co. v. Williams Bros. Well Treating Corp.*, 81 F. (2d) 495, reversing the District Court for the Northern District of Oklahoma which had adjudged the patent invalid, the court in that case did not have before it a large part of the evidence in the record in this case. In its brief before this Court petitioner has the temerity to represent that had this evidence been presented to the Court of Appeals for the Tenth Circuit, it would have "strengthened plaintiff's case instead of weakening it." Nothing could be further from the truth. The findings of fact entered by Judge Tuttle in the court below in this case include the following:

"But the record before this court here contains a large amount of new evidence not before the courts in that case, and this new evidence is of such a character that it may fairly be concluded that the Circuit Court of Appeals for the 10th Circuit would have reached a different conclusion had it been advised of its existence." [Vol. III - 1485.]

Since the decree below holding the patent in suit invalid is based on concurrent findings of fact and conclusions of law, we cannot see what petitioner can hope to accomplish by a hearing in this Court.

*Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*,  
decided Feb. 28, 1944, 88 L. ed. 475.

IV.

**ARGUMENT.**

The purpose of The Dow Chemical Company in seeking to avoid a consideration of the issue of infringement in this case at the time that this Court would be considering the issue of validity of the patent in suit is manifest. The issues of validity and infringement of a patent, both involving as they do an interpretation of the scope of the patent, should not ordinarily be separately adjudicated. Where the charge of infringement involves a stretching of the scope of the patent, the validity of the patent should be determined with the same broad consideration. A patent owner should not be permitted to support the validity of his patent upon narrow grounds and at the same time urge infringement of the patent upon broad grounds. Yet that is what the patent owner in this case hopes to do and is why it seeks to forestall any consideration of the issue of infringement by this Court. The situation is so apparent that we do not feel the point requires further argument.

We will not attempt to urge upon this petition the merits of respondent's defense of non-infringement. It is sufficient to say that the defense is substantial, as is apparent from our previous statement. It is true that both the District Judge and the Judges of the Court of Appeals in this case have reached conclusions on this issue against respondent. However, in view of the fact that both the District Court and the Circuit Court were in the process of holding the patent in suit invalid, the issue of infringement received scant attention in both courts. This is not unusual in patent cases, and the fact that it is not unusual demonstrates the necessity for an appellate

court to consider the scope asserted for a patent on the issue of infringement at the same time that the appellate court is determining the validity of the patent.

The issue of infringement to be determined before this court if respondent's cross petition be granted would be a legal issue. We do not challenge the findings of the District Court as to how respondent protects its transportation tanks or the fact that in so doing the hydrochloric acid picks up minute amounts of chlorides which to some extent reduce the corrosiveness of the acid~~s~~ during its progress down the well. We do, however, contend that this practice should not be held to constitute an infringement of the patent in suit. We would expect to show to this Court that the minute amounts of chlorides picked up by the hydrochloric acid while in respondent's transportation tanks do not correspond in nature or amount with the inhibitors called for by the patent in suit; that such chlorides are embraced within the metallic chlorides which were disclaimed during the prosecution of the patent in suit; and that to sustain the patent in suit and the charge of infringement in this case would be to give petitioner a monopoly covering any and every means of rendering hydrochloric acid less corrosive during its use for acidizing a well.

Accordingly it is respectfully submitted that if this Court should undertake to review the validity of the patent in suit, it should also review the issue of infringement in this case.

Respectfully submitted,

LEONARD S. LYON,

*Attorney for Respondent.*